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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/871,243	05/31/2001	Robert Angelo Mercuri	P-1038	8204
23456	7590	10/19/2005	EXAMINER	
WADDEY & PATTERSON 1600 DIVISION STREET, SUITE 500 NASHVILLE, TN 37203			FERGUSON, LAWRENCE D	
			ART UNIT	PAPER NUMBER
			1774	

DATE MAILED: 10/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/871,243

Applicant(s)

MERCURI ET AL.

Examiner

Lawrence D. Ferguson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-13,29,30 and 34-50 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 29,30 and 34-38 is/are allowed.
- 6) ☒ Claim(s) 1,3-13 and 39-50 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. This action is in response to the amendment mailed March 21, 2005. Claims 28,29,36 and 51 were amended and claim 33 was cancelled. Examiner withdraws the previous rejections to further prosecute the claimed invention. Claims 1, 3-13, 28-30, 32 and 34-51 are pending in this case.

The indicated allowability of claims 28 and 51 are withdrawn in view of the newly discovered reference(s) to Feldman et al (U.S. 5,622,774). Rejections based on the newly cited reference(s) follow.

Claim Rejections – 35 USC § 103(a)

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 3-13, and 39-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over White et al (U.S. 6,335,4,328,974) in view of Mercuri et al (U.S. 5,902,762) further in view of Feldman et al (U.S. 5,622,774).

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White discloses a material comprising flexible graphite, where the flexible graphite has two different densities of 1.1 g/cc and 0.7 g/cc (column 1, line 49 through column 2, line 15) where the low density flexible graphite sheet (30 of Figure 1) is in contact with a second high density flexible graphite sheet (32 of Figure 1) to form a composite. White does not explicitly disclose the flexible graphite sheets are resin-impregnated.

Mercuri teaches a composite of a resin impregnated flexible graphite sheet or foil (column 2, lines 17-36) where the sheet has a thickness of from 0.1 to 3.5mm (column 4, lines 38-40). Mercuri further teaches a phenolic based resin (column 4, lines 9-11). White and Mercuri are both directed to flexible graphite sheet material. It would have been obvious to one of ordinary skill in the art to include the resin impregnated sheets in the flexible graphite material of White to provide improved permeability and stability in the flexible graphite material (column 2, lines 17-19). Regarding the preamble of a material "useful as a substrate for an embossed flexible graphite sheet", it is noted the preamble merely states the intended use of the invention rather than any distinct definition of any of the claimed invention's limitations such that the preamble is given little weight and is not considered to further limit the claim (See MPEP 2111.02). Regarding claims 7 and 39, White et al. as modified by Mercuri et al. does not specifically require a particular flexible graphite sheet material area weight as it would have been obvious to one of ordinary skill in the art, at the time the invention was made to experimentally determine the flexible graphite sheet material area weight as a

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function of the particular densities required, amount of resin used, etc. as doing so would have required ordinary skill and routine experimentation.

Neither reference discloses a foraminous material. Feldman teaches a flexible graphite composition having a foraminous layer (column 3, lines 30-40 and column 4, lines 42-45). All of the references are directed to flexible graphite sheet material. It would have been obvious to one of ordinary skill in the art to have employed the foraminous material, as taught in Feldman, in the material of White and Mercuri because the foraminous material provides improved flexibility of the composition and improves bonding between the sheets.

4. Claims 29-30 and 34-38 are allowed. The closest prior art does not teach or suggest the recited material further including a where one flexible graphite sheet comprises between 0.1 g/cc up to 1.3 g/cc and the second flexible graphite sheet comprises at least 1.4 g/cc to no more than 1.8 g/cc. The prior art does not teach motivation or suggestion for modification to make the invention as instantly claimed.

Response to Arguments


5. Applicant's arguments made regarding rejection made under 35 U.S.C. 103(a) as being unpatentable over White et al (U.S. 6,335,4,328,974) in view of Mercuri et al (U.S. 5,902,762) are moot based on grounds of new rejection.


Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lawrence Ferguson whose telephone number is 571-272-1522. The examiner can normally be reached on Monday through Friday 9:00 AM – 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye, can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


L. Ferguson
Patent Examiner
AU 1774


RENA DYE
SUPERVISORY PATENT EXAMINER
A.U. 1774 01/14/05